

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/822,426	Applicant(s) DEANE ET AL.
Examiner NIKOLAI A. GISHNOCK	Art Unit 3715

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 7, 10, 12-15, 20-25, 28-30, 33, 35-37 and 40-59.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/XUAN M. THAI/
Supervisory Patent Examiner, Art Unit 3715

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments directed to Sweitzer, Bloom, and Erickson are not persuasive because applicant asserts an overly narrow reckoning of the term automatically; see In re Zletz and MPEP 2111.01; "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow". In this case, Sweitzer is not "already admitted" not to disclose automatically choosing one or more of word order, etc.; what Sweitzer does not teach is basing the choosing on a determined relationship between a first and second number variables. However, Bloom teaches building a discourse (18:51-64) based on parameters (5:31-46), including strings and functions (17:31-36). It is examiner's position that the methods of Sweitzer, Bloom, and Erickson are performed automatically is any part is performed by the computer; the common meaning of the term "automatic" does not require that every possible element is performed without the possibility of human intervention. For example, an automobile does not drive itself, thus, even though it moves automatically, it still requires an operator. In response to applicant's arguments that Sweitzer, Bloom, and Erickson individually fail to teach the claim limitation, one cannot show nonobvious by attacking the references individually where the rejection is based on a combination; see MPEP §707.07(f). Bloom and Erickson are understood to have the author build up knowledge bases and adjust parameters; see Bloom at 5:58-64. It would have been obvious to merely have the computer automatically assemble this information based upon numerical variables contained in the parameters, despite whether these parameters came from an author's specification of a word problem or further automatically (such as an unmodified default problem). Further, applicant's own invention as disclosed (see Para. 0061 and Figure 3 of the specification) indicates where a user alters the variables for which the assessment item solves, etc.; this method is not more "automatic" than what is disclosed by Sweitzer, Bloom, Wen, and Erickson. As such, applicant's arguments are not persuasive, because, although the claimed invention performs "automatically", what is being argued exceeds the scope of what is disclosed and thus these arguments are not supported.